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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,590	11/12/1999	ANDREA CONCANNON	P/2167-125	9576
21967	7590	07/19/2006	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			LIVERSEDGE, JENNIFER L	
		ART UNIT	PAPER NUMBER	
			3628	
DATE MAILED: 07/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/438,590	CONCANNON ET AL.	
	<b>Examiner</b> Jennifer Liversedge	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/15/2006 has been entered.

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/438,590 filed on November 12, 1999.

The amendment contains original claims: 2-5 and 7-13.

The amendment contains amended claims: 1 and 6.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 5,787,402 to Potter et al. (further referred to as Potter).

Regarding claims 1 and 6, Potter teaches a system and method for processing funds transfer transactions from a customer of a financial institution (See Potter et al. figure 1, and column 1, lines 9-14, "The present invention relates generally to methods and systems for performing automated financial transactions, and more particularly to a method and system for performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution."), the system comprising:

a first processor receiving a bulk file from the customer (See Potter et al. figure 1, item 10, column 3, lines 19-25, "Customers can access the system on-line and in real time through various terminals such as, for example, a personal computer (PC). By inputting information in response to prompts on the screen, the system quickly identifies the nature of the transaction the customer desires and the customer inputs the characteristics of the transaction the user desires; column 5, lines 15-32; column 15, lines 5-46, "...the Batch File Server determines which of the messages contained in the financial institution's mainframe are for foreign currency exchange..."), the bulk file containing a plurality of funds transfer transactions, the first processor:

(1) determining which of the plurality of funds transfer transactions is a foreign exchange transaction (See Potter Column 1, lines 9-14; Column 5, lines 15-32; Column 15, lines 5-46, "...the Batch File Server determines which of the messages contained in the financial institution's mainframe are for foreign currency exchange..."), and

(2) grouping the plurality of funds transfer transactions into funds transfer transactions requiring a foreign exchange operation, denoted as foreign exchange funds transfer transactions (See Potter Column 3 lines 13-18 "a method and system for initiating and executing foreign exchange transactions. The improved method and system deals in virtually all trading currencies, automatically incorporates the current market process and operates in a secure environment."); and Column 5, lines 15-32; Column 15, lines 5-46)), and funds transactions not requiring a foreign exchange operation, denoted as same currency funds transfer transactions (See Potter et al. column 3, lines 57-63, "Further, the system enables users to perform money market transactions in which a user may deposit money in a first currency and automatically obtain interest on that deposit in the first currency."); and Column 5, lines 15-32; Column 15, lines 5-46);

a second processor coupled to the first processor, the second processor receiving the same currency funds transfer transactions not requiring a foreign exchange operation from the first processor (See Potter figure 1 item 16 "Money Market GUI" and figure 2, item 106 "Money Market Server" column 5, lines 3-6 "Money Market Trade Execution Server (Money Market Server). This server allows a client to deposit a foreign currency for a short-term deposit at a specified deposit rate"), the second

processor generating first funds transfer instructions in response to the same currency funds transfer transactions (See Potter column 5, lines 11-14, "both principal and interest accrued at the specified deposit rate, with principal and interest returned to the client in the original currency.");

a funds transfer processor coupled to the second processor, the funds transfer processor receiving the first funds transfer instructions from the second processor and executing the received first funds transfer instructions by transferring funds to a funds transfer processor of another financial institution (See Potter column 15, lines 16-60); and

a trading processor coupled to the first processor, the trading processor receiving the foreign exchange funds transfer transactions from the first processor, the trading processor executing a foreign exchange operation in response to the received foreign exchange funds transfer transactions (See Potter figure 2, item 118; column 4, line 45 - column 13, line 10; column 15, lines 36-46).

Regarding claims 2 and 7, Potter discloses the system and method wherein:  
the trading processor is coupled to the second processor, the trading processor forwarding to the second processor the foreign exchange funds transfer transactions and funds resulting from the foreign exchange operation, the second processor generating second funds transfer instructions in response to the foreign exchange funds transfer transactions and funds resulting from the foreign exchange operation, and the funds transfer processor receiving the second funds transfer instructions from the

second processor and executing the received second funds transfer instructions by transferring funds to a funds transfer processor of another financial institution (Figure 1 item 40 Bank 2; column 1, lines 9-14; column 4, lines 45-52; column 5, lines 21-33).

Regarding claim 3, Potter discloses the system further comprising a link coupling the first processor to a system of the customer, wherein the customer system transmits the bulk file to the first processor (Figure 1, item 10 Customer; column 1, lines 9-14; column 4, lines 45-52).

Regarding claim 4, Potter discloses the system further comprising a firewall disposed in the link coupling the first processor to the customer system (See Potter Figures 1 and 2 which do not illustrate the commonly used firewall implemented by software however the examiner declares Official Notice that a firewall was a well known security device that prevents unauthorized users from gaining access to the internal bank system and the customer and bank would be motivated to use firewalls to prevent unauthorized hackers from causing damage).

Regarding claim 5, Potter discloses the system further comprising a market link from the trading processor to a foreign exchange market, wherein the trading processor receives real time foreign exchange rates over the link (Figures 1 and 2 and column 1, lines 9-14).

Regarding claim 8, Potter discloses the method further comprising the step of separating the bulk file into its component funds transfer transactions, the component funds transfer transactions including the foreign exchange funds transfer transactions and the same currency funds transfer transactions (column 3, lines 57-63; column 5, lines 14-33; column 15, lines 6-46).

Regarding claim 9, Potter discloses the method further comprising the step of sending an acknowledgment to the customer upon receipt of the bulk file and upon the settlement of the funds transfer transactions (Figures 18-26; column 15, lines 44-59).

Regarding claim 10, Potter discloses the method further comprising the step of grouping the foreign exchange funds transfer transactions into batches according a market in which the foreign exchange operation is to take place (column 5, lines 15-33; column 15, lines 6-52).

Regarding claim 11, Potter discloses the method further comprising the step of validating the format and contents of the batches (The examiner declares Official Notice that this feature was known as "error checking" and is commonly practiced by the banks to prevent errors which can cost money).

Regarding claim 12, Potter discloses the method further comprising the step of validating the format and contents of the foreign exchange funds transfer transactions

contained in the batches (The examiner declares Official Notice that this feature was known as "error checking" and is commonly practiced by the banks to prevent errors which can cost money).

Regarding claim 13, Potter discloses the method further comprising the step of aggregating the foreign exchange funds transfer transactions contained in the batches according to a currency of the foreign exchange operation (Column 5, lines 15-33; column 15, lines 6-46).

#### ***Response to Arguments***

Applicant has argued that the previously cited references do not disclose determining which of the plurality of funds transfer transactions are foreign exchange transactions, as amended in claims 1 and 6. However, the Examiner specifically points to columns 5 and 15 where Potter discloses batch processing where components are broken down in order to execute transactions based on identifying foreign exchange transactions. Specifically, column 15, lines 39-44 refers to receiving SWIFT and bulk files and states "If from the latter, the Batch File Server determines which of the messages contained in the financial institution's mainframe are for foreign currency exchange by the Payment Order server, retrieves those messages and passes these messages to the Payment Order Server." This process is conducted by the system servers, not by customer's using the service, and the process is done automatically by the system.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent No. 5,774,553 to Rosen discloses real-time foreign exchange settlement (column 2, lines 1-8) where transfers are assembled, sent to a receiver, and then disassembled for processing (column 13, lines 7-14), where transaction netting occurs (column 26, lines 27-67 and column 27, line 53 – column 28, line 10) and notification is received of the settlement (column 30, lines 9-10).

US Patent No. 6,058,378 to Clark et al discloses links for comprehensive financial transactions (column 3, lines 15-18), where the transaction is routed to the appropriate service based on the event (column 7, lines 25-29 and column 11, lines 12-19) and where transactions which are awaiting authorization can be sorted based on criteria including currency (column 20, lines 27-32) and where these batches of transactions are delivered as a batch via the server at pre-scheduled times (column 27, lines 30-36 and column 28, lines 12-17).

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

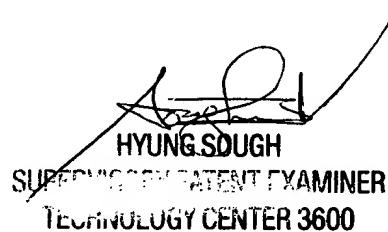
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

Art Unit 3628



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